

## **REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1 and 3-21 are pending in this application. Claims 1, 6, 13, 17, 18, 20 and 21 are independent. Claims 1, 13, 17 and 18 have been amended by the present amendment. Claims 20 and 21 have been added by the present amendment.

### ***Interview Summary***

On 25 February 2010, applicant's undersigned representative conducted a personal interview with Examiner William Gilbert at the USPTO. The following is a complete and proper recollection of the substance of the interview: (A) No exhibits were shown and no demonstrations were conducted; (B) Claims 1, 13, 17 and 18 were discussed; (C) Evjen (USPubN 2004/035079) and Theirs (USPubN 2006/0032168) were discussed; (D) the amendments presented above were discussed; (E) the general thrust of the principal arguments of the applicant and the examiner are those presented below; (F) no other pertinent matters were discussed; (G) the general results or outcome of the interview was that applicant would file the present amendment; and (H) the interview was not via electronic mail.

### ***Allowed Claims and Double Patenting***

Applicant appreciates Examiner Gilbert's indication that Claims 6-12 are allowed. Claims 6-12 have also been included in the double patenting rejection of claims a and 3-19 over copending application no. 10/975,923, which issued as U.S.

Patent No. 7,677,001 on 16 March 2010. Applicant includes herewith a terminal disclaimer obviating the double patenting rejection of claims 1 and 3-19.

***Art Rejection***

The Office Action rejects claims 1, 3-5 and 13-19 under 35 U.S.C. §103(a) over Evjen (USPubN. 2004/0035079) in view of Thiers (USPubN 2006/0032168). The rejection is respectfully traversed.

--Independent Claim 1--

As discussed during the Examiner Interview, Evjen does not teach that a short side is lockable to a long side. That is, the tongue 18 and groove 20 are not compatible with the male 16 and female elements 14. Neither the tongue 18 nor the groove 20 can be fitted to either of the male 16 or female 14 elements. Therefore, a "short" side of one of the modified panels 10 would not connect to a "long" side of another modified panel 10 in the manner shown, for example, by Thiers.

Further, as discussed during the Examiner Interview, the Official Action mailed on 27 November 2009 recites, on page 5, that "applicant has not respectfully positively recited that the mirror-inverted panels are connected to each other."

In order to advance prosecution, applicant has amended claim 1 at the suggestion of the Examiner to recite that "the mirror inverted panels are connected to each other" and that "a short side is lockable to a long side." Accordingly, applicant maintains that claim 1 is patentable over Evjen in view of Thiers. Claims 3-5 depend from claim 1 and are at least patentable for that reason.

--Independent Claim 13--

As discussed during the Examiner Interview the combination of Evjen and Thiers does not teach or suggest the presently claimed invention of claim 13.

As shown in an embodiment, to which claim 13 is not limited, Figures 13a-f of the present application shows a unique and new method installation.

With boards of all the same type (no mirror inverted panels involved), an installer will install a first row. Then, when starting the second row, the Examiner will have to move all the way back to where the first row was started. This same move all the way back is required for each subsequent row. This may take a considerable time when large surfaces are installed. An example (to which the claimed invention is not limited) is shown in Figure 13b, where a first row is laid starting with A1 at one end of the subfloor and ending with A3 at the second end of the subfloor. Then, when the second row is started, the installer has to move back to the end of the subfloor where A1 was laid to lay the panels of the second row. And, then when the third row is started, the installer will again move back to the end of the subfloor where A1 was laid to lay the panels of the third row.

However, an installer following the method of the claimed invention will not have to move as much.

This is because when the installer reaches the end of the first row, and is ready to start the second row, the installer does not have to move back to the end of the subfloor where the first row was started. Instead, by use of the mirror inverted floor panel, the installer is able to start the second row right where the first row ended.

Claim 13 recites, *inter alia*, that a second row is formed by joining a long side of floorboard of the second type in the second row **directly** to the last laid floorboard of the first type in the first row.

Accordingly, applicant maintains that claim 13 is patentable over Evjen in view of Thiers. Claims 14-16 and 19 depend from claim 13 and are at least patentable for that reason.

--Independent Claim 17--

As discussed during the Examiner Interview the combination of Evjen and Thiers does not teach or suggest the presently claimed invention of claim 17.

As shown in an embodiment, to which claim 17 is not limited, Figures 14a-d of the present application shows a unique and new method installation.

FIGS. 14a-d show a rational installation in parallel rows using A and B boards with mirror-inverted joint systems. According to FIG. 14a, for instance the rows R1-R5 with A boards are started. Then a movement takes place and the remaining A boards are installed according to FIG. 14b. In the next step, rows of B boards are started, after which a movement takes place and the remaining B boards can be installed. Installation of these ten rows can thus take place with only two movements.

Claim 17 recites, *inter alia*, that a second row of floorboards is formed by locking together two long sides of at least two floorboards of the first type of floorboard in the second row by angling towards two similar floorboards of the same type in a first row; and that a third row of floorboards is formed by locking together a long side of a floorboard of the second type of floorboard with a long side of a floorboard of the first type of floorboard in the second row by inward angling, and that a fourth row of floorboards is formed by locking together a long side of a floorboard

of the second type of floorboard with a long side of a floorboard of the second type of floorboard in the third row by inward angling.

Accordingly, applicant maintains that claim 17 is patentable over Evjen in view of Thiers.

--Independent Claim 18--

As discussed during the Examiner Interview, Evjen does not teach that a short side is lockable to a long side. That is, the tongue 18 and groove 20 are not compatible with the male 16 and female elements 14. Neither the tongue 18 nor the groove 20 can be fitted to either of the male 16 or female 14 elements. Therefore, a "short" side of one of the modified panels 10 would not connect to a "long" side of another modified panel 10 in the manner shown, for example, by Thiers.

Further, as discussed during the Examiner Interview, the Official Action mailed on 27 November 2009 recites, on page 5, that "applicant has not respectfully positively recited that the mirror-inverted panels are connected to each other."

In order to advance prosecution, applicant has amended claim 18 at the suggestion of the Examiner to recite that "the mirror inverted panels are connected to each other" and that "a short side is lockable to a long side." Accordingly, applicant maintains that claim 18 is patentable over Evjen in view of Thiers.

--Independent Claim 20--

New claim 20 has been added by the present amendment. Support for new claim 20 may be found throughout the specification, original claim 1 and the drawing Figures. Claim 20 mirrors claim 1, except that claim 20 does not recite that said pair

of opposing connectors of said short sides are adapted for locking the floorboards only horizontally.

However, claim 20 does recite that "the mirror inverted panels are connected to each other" and that "a short side is lockable to a long side." Accordingly, applicant maintains that claim 20 is patentable over Evjen in view of Thiers.

--Independent Claim 21--

New claim 21 has been added by the present amendment. Support for new claim 21 may be found throughout the specification, original claim 1 and the drawing Figures. Claim 21 mirrors claim 1, except that claim 21 does not recite that a short side is lockable to a long side.

However, claim 21 does recite that "the mirror inverted panels are connected to each other." Accordingly, applicant maintains that claim 21 is patentable over Evjen in view of Thiers.

Further, with regard to each of claims 1, 3-5 and 13-21, applicant maintains that one skilled in the art would not have combined Evjen with Thiers in a manner to arrive at the claimed invention.

Evjen discloses a paneling system for interconnecting panels 10 with opposite connecting sides of substantially tongue in groove joint couplings 18, 20 and opposing adjacent connecting sides that are of substantially hook-joint coupling 14, 16 (see Abstract and Figs. 2-4). Each panel 10 is identical to other panels 10 (see Fig. 4). The Office Action acknowledges that Evjen fails to disclose that the panels 10 are two different types of panels, and that the couplings of one type of panel 10 along one pair of opposite edge portions are arranged in a mirror inverted manner relative to the corresponding couplings along the same pair of opposite edge

portions of another type of panel 10. The Office Action asserts that these features are disclosed by Thiers, and that it would have been obvious to one skilled in the art to modify the Evjen's panels 10 in view of Theirs to make the panels of two different types that are mirror images of each other. Applicant respectfully disagrees.

In particular, the Office Action states that "Their's is not the focus of the rejection, but rather that panels *can* be made in a mirror image fashion for connection" (see page 4 of the Office Action, emphasis added). This statement is inadequate evidence to support the Office Action's conclusion that it would have been obvious to one skilled in the art to modify Evjen's panels 10 to make the panels of two different types that are mirror images of each other. Specifically, the Office Action merely states that the modification can be possible. According to the Patent Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103(a) in view of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007), the Examiner should clearly articulate why the claimed invention would have been obvious. For example, the Supreme Court in *KSR* held that the Examiner "must [provide] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*KSR* at 1396). The Supreme Court noted that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art" (*Id.*). In other words, simply because something *could have been* modified and a person of ordinary skill was capable of making the modification does not mean it would have been obvious to do so. To establish obviousness, it must be shown that those of ordinary skill in the art would have had some "apparent reason to combined the known elements in the fashion claimed" (*Id.*).

In this case, it is not at all apparent why one skilled in the art would have been led to the stated modification. Applicant submits that there is no reason why one skilled in the art would have modified Evjen's panels 10 in the manner stated by the Office Action. For example, modifying the panels 10 to provide two types of panels, by mirror inverting the connectors of one panel relative to another, would unnecessarily change how the floor panels fit together without providing any additional benefit. In Evjen, all of the panels 10 are the same, as discussed above. The tongue 18 is received in the groove 20, and male element 16 is received in female element 14 to secure the panels 10 together. In this configuration, all of the couplings (i.e. tongue, groove, female element, male element) are located at the same relative position on each of the panels 10. To the extent the panels 10 would have even been physically able to be fit together without the modified couplings interfering with each other, an adjacent panel 10, with mirror inverted connectors, would need to be rotated 180 degrees relative to an existing panel 10. For example, if the tongue 18 and groove 20 were mirror inverted on one panel 10 relative to another panel 10, the modified panel would have to have been rotated 180 degrees so that the tongue 18 would still be received in groove 20. The resulting floor surface would have then been the same pattern as the original floor surface, as the long sides of the panels would still have been positioned adjacent to one another. Thus, there would have been no reasons why one skilled in the art would have modified Evjen's panels 10 to make the panels of two different types that are mirror images of each other. Therefore, there is inadequate evidence supporting the Office Action's conclusion that it would have been obvious to one skilled in the art to modify Evjen's panels 10 to make the panels of two different types that are mirror images of each other.



Moreover, the stated modification would not have provided options for additional pattern forming with the panels 10 as asserted by the Office Action (see page 4 of the Office Action). On the contrary, the stated modification would have *reduced* the pattern forming options of the panels 10. In particular, the tongue 18 and groove 20 are not compatible with the male 16 and female elements 14. That is, neither the tongue 18 nor the groove 20 can be fitted to either of the male 16 or female 14 elements. Therefore, a "short" side of one of the modified panels 10 would not connect to a "long" side of another modified panel 10 in the manner shown, for example, by Thiers. Accordingly, additional patterns would have been precluded from being formed if Evjen's panels 10 were modified in the manner stated by the Office Action.

For at least the above reasons, the combination of Evjen and Thiers does not disclose, and would not have rendered obvious, the combination of features recited in the independent claims of the present application.

### ***Conclusion***

For at least the reasons stated above, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections, and to allow the present application.

In the event that there are any questions concerning this amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned attorney so that prosecution of the application may be expedited.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: 24 May 2010

By:

A handwritten signature in black ink, appearing to read "T.D. Boone", written over a horizontal line.

Travis D. Boone

Registration No. 52635

**Customer No. 21839**

703 836 6620